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In re Application of ARIMA et al.
Application No.: 09/403,603
PCT No.: PCT/JP98/01844
Int. Filing Date: 22 April 1998
Priority Date: 23 April 1997
Attorney Docket No.: 19051.072
For: ELECTRODE AND BATTERY

DECISION

This is a decision on applicants' "Request for Reconsideration of Renewed Petition Under 37 CFR 1.182/Petition Under 37 CFR 1.47(a)", filed in the United States Patent and Trademark Office (USPTO) on 09 February 2001.

BACKGROUND

On 03 December 1999, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the declaration must be filed in compliance with 37 CFR 1.497(a) and (b) along with a surcharge for filing the declaration after the thirty month period.

On 31 May 2000, applicants submitted a declaration executing PCT/JP98/01844 with a petition for extension of time for a five month period. A copy of the declaration was again submitted by facsimile on 15 June 2000.

On 29 June 2000, Notification of Defective Response (Form PCT/DO/EO/916) and Notification of Defective Oath or Declaration (Form PCT/DO/EO/917) were mailed to applicants indicating that the declaration submitted was not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68 and did not identify the inventors. Specifically, Form PCT/DO/EO/916 indicated that "the declaration has two sole or first inventors, Yoichiro Arima and Hisashi Tsukamoto. The names of the fifth and seventh inventors on the declaration does not correspond with the published IA [international application]".

On 18 September 2000, in response to the Notification of Defective Response and Notification of Defective Oath or Declaration, applicants refiled the originally filed declaration with hand-written revisions to the inventor order and changes in two inventors' last names in ink and highlighted. A change of address was also filed. The filing was considered a petition under 37 CFR 1.182.

On 12 December 2000, a decision on applicant's submission was mailed to applicant indicating that the declaration as filed was unacceptable because the declaration named two individuals as the first or sole inventor, two individuals as second inventor, two individuals as third inventor and the declaration did not list all the inventors named on the publication. The declaration filed on 31 May 2000 also indicated a correction to the spelling of the fifth and seventh listed inventor's names. No explanation was provided for either change.

On 09 February 2001, applicants filed a "Renewed Petition Under 37 CFR 1.182" with a new declaration executed by eight of the nine inventors and an explanation of the refusal of inventor Hisashi Tsukamoto to sign the declaration.

On 19 July 2001, a decision was mailed to applicants indicating that the evidence presented was insufficient to prove that Mr. Tsukamoto refused to sign the application. What was required was that Mr. Tsukamoto be presented with a copy of all of the national stage application papers (oath and declaration, specification, including claims and drawings) for the application as identified above. Applicants were further advised that the application was considered abandoned as the application file did not indicate a timely response to the 29 June 2000 notifications.

On 26 July 2001, a Notification of Abandonment was mailed to applicants indicating that applicant had failed to properly respond to the notifications mailed on 29 June 2000.

On 25 July 2002, applicants filed a renewed petition requesting acceptance of the application without the signature of Mr. Tsukamoto along with a petition to revive the application under 37 CFR 1.137(a) and \$110 petition fee.

DISCUSSION

Applicants request that the declaration be accepted without the signature of inventor Hisashi TSUKAMOTO. As noted in the previous decision, to accept an application without the signature of an inventor, a petition under 37 CFR §1.47(a) must be filed. The petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s). Items (1), (3), and (4) have been submitted and satisfy the requirements of 37 CFR 1.47(a).

In their renewed petition, applicants attempt to show that the non-signing joint inventor refuses to execute the application with (1) the declaration of Toshiaki Nakano, (2) a copy, and English translation thereof, of a letter sent to Mr. Tsukamoto requesting his signature on the declaration, and (3) a copy of the DHL package receipt addressed to Mr. Tsukamoto's last known address and DHL tracking air cargo receipt indicating delivery on 24 August 2001..

Petitioner submitted the declaration of facts under 37 CFR § 1.47(a)(2) signed by the General Manager, Intellectual Property Center for Japan Storage Battery Company, Toshiaki Nakano. In his declaration, made upon first hand knowledge, Mr. Nakano states that he sent a letter on 21 August 2001 to Mr. Tsukamoto along with a copy of the specification, abstract, claims and drawings and declaration and power of attorney for PCT/JP98/01844 requesting his signature on the declaration.

Mr. Nakano's declaration states that "I sent a letter requesting Mr. Tsukamoto to sign the

Declaration. The declaration/power of attorney was attached to the parts of the specification (Abstract and Claims and the drawings). The papers were sent by DHL. A copy of the receipt from DHL, showing that the papers were delivered to Mr. Tsukamoto, is attached hereto."

The DHL receipt indicates that these papers were delivered on 24 August 2001. As of the date of Mr. Nakano's declaration (5 July 2002), Mr. Tsukamoto had not returned the papers or the declaration/power of attorney or responded to the request to sign the application.

This is sufficient evidence to conclude that applicant/inventor Hisashi Tsukamoto has refused to sign the application. While Petitioner has demonstrated that: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 09/403,603 (specification, including claims, drawings, and declaration/power of attorney) to the nonsigning inventor for his signature, sent to his last known address and (2) Mr. Tsukamoto's conduct constitutes a refusal to sign these documents.

Petition to Revive under 37 CFR 1.137(a)

The application was held abandoned because applicant had failed to timely reply to a Notification of Defective Response and Notification of Defective Oath or Declaration mailed on 29 June 2000. Applicant alleged that he mailed an executed declaration on 17 July 2000 but this submission is not found in the application file. Applicant was advised to file petition under 37 CFR 1.181 providing a copy of the USPTO date-stamped postcard receipt for 17 July 2000.

Instead, on 25 July 2002, applicant filed a petition to revive the abandoned application under 37 CFR 1.137(a).

As stated in the MPEP §711.03(c) 2.Unavoidable Delay,

"unavoidable" delay is the epitome of "unintentional" delay. Thus, an intentional delay precludes revival under 37 CFR 1.137(a)("unavoidable" delay) or 37 CFR 1.137(b) ("unintentional" delay). See *Maldaque*, 10 USPQ2d at 1478.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also *Winkler v. Ladd*, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."

Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the requisite petition fee; (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 1.20(d)) required pursuant to 37 CFR 1.137(c). Applicant has satisfied items (1) and (2). Item (4) is not required. As for Item (3), counsel attached an unsigned Summary providing the following explanation:

the reason for the delay has been the time required for Applicants counsel, the assignee's Japanese patent representative, and the responsible officials of the assignee in connection with reporting the July 19, 2001 Decision, determining what actions were required and which individuals, preparing new documents to be sent to the non-signing inventor, obtaining information about and preparing a declaration describing the efforts made to obtain the nonsigning inventor's signature, and then preparing the accompanying petitions.

This explanation is insufficient to prove that the application was unavoidably abandoned given the application history. The application became abandoned for failure to reply to Notification of Defective Response and Notification of Defective Oath or Declaration mailed on 29 June 2000. In the submission filed on 18 September 2000, Counsel indicated that an executed declaration in response to the 29 June 2000 Office action was submitted on 17 July 2000. To now argue that period of time between the mailing of the 19 July 2001 decision and the response filed on 25 July 2002, which is more than one year, was necessary and unavoidable is not responsive to the initial reason for the delay.

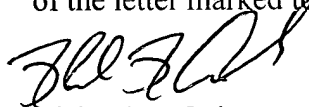
CONCLUSION

For the reasons above, the application is considered **ABANDONED**.

Applicant has satisfied the requirements of 37 CFR 1.47(a). The declaration submitted on 09 February 2001 is acceptable. However, the application is considered abandoned. The decision is held in abeyance pending revival. The case will be held in the PCT Legal Office to await applicant's reply.

Any reply or petition to revive the application must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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